

## **IP Section Licensing Committee Meeting**

**Friday, February 17, 2005 8:30 a.m. — 9:30 a.m.**

### **MINUTES**

**PARTICIPANTS:** Kevin DeBré (Chair; [kdebre@biztechlaw.com](mailto:kdebre@biztechlaw.com)), Jebb Dykstra, Danielle Fern, Martin Fern, Joshua Hofheimer, Michael Krieger, Michael Plumleigh, Lee Rawles, Tom Speiss (Secretary; [tspeiss@bakerlaw.com](mailto:tspeiss@bakerlaw.com)), and Jim Wright.

#### **I. Introduction.**

Kevin DeBré welcomed the participants, and each caller identified themselves.

#### **II. Items Discussed.**

The items discussed during this meeting included: (1) the minutes of the January 20, 2006 meeting; (2) selection of a topic for one or more presentations at the 31<sup>st</sup> Annual IP Institute; (3) planning of social mixers for Committee members; (4) the LIMA Advanced Licensing Workshop; (5) status of the online discussion board; and (6) scheduling of future Committee conference calls.

##### **1. Minutes of the January 20, 2006 Meeting.**

Tom Speiss briefly summarized the minutes of the January 20, 2006 meeting. These minutes are available on the webpage for the Licensing Committee, which is accessible through the IP Section website located at [www.ipsection.org](http://www.ipsection.org).

##### **2. Topics for Presentations at the 31<sup>st</sup> Annual Intellectual Property Institute.**

Committee members discussed possible topics for one or more presentations at the Annual IP Institute. Many of these topics were suggested through the Committee's Google Group accessible at <http://groups.google.com/group/IPLC>. These include: (1) the Impact of the Create Act on JVs and Research Collaborations; (2) Primer on GPL v3; (3) IP Issues in Acquisition — Due Diligence, Reps & Warranties and Beyond; (4) US Jurisdiction and Choice of Law Issues in International License Agreements; (5) IP Licensing in the post-*Grokster* World; (6) Has Fair Use Gone too Far?; and (7) Best Practices in Licensing.

After discussion, the Committee decided to submit two topics to the Institute planning committee: (1) Best Practices in Licensing; and (2) IP Issues in Acquisition — Due Diligence, Reps & Warranties and Beyond. The Committee further discussed specific elements that can be part of these presentations, such as issues relating to franchises, management of open source licenses and how to address IP issues that arise in the course of due diligence.

##### **3. Social Mixers**

Adam Samuels is planning social mixers for members of the Committee. He had earlier suggested that the first social mixer for the Southern California contingent of the

Committee could take in Los Angeles, perhaps at The Biltmore or Checker's. Mr. Speiss suggested that the event could take place at the City Club, which sits atop the Wells Fargo Center located on Bunker Hill.

Michael Plumleigh, based in San Francisco, agreed to assist Mr. Samuels in the planning of an event for members in Northern California.

The Committee further discussed whether the State Bar would pay for any portion of the event. Michael Krieger suggested including a brief MCLE component. Martin Fern agreed to give a brief presentation on franchise issues that arise in trademark licensing. Mr. DeBré said that he would check with the State Bar about the availability of funding for these events.

Mr. Speiss suggested that Committee members post their planned attendance at any licensing trade show events in the Google Group, so that members could meet informally. He mentioned that he and Jim Wright met at the recent 2006 International CES in Las Vegas.

#### **4. The LIMA Advanced Licensing Workshop.**

Mr. DeBré mentioned that the State Bar had been contacted by the International Licensing Industry Merchandisers' Association ("LIMA"), [www.licensing.org](http://www.licensing.org), concerning the West Coast Session of the spring 2006 Advanced Licensing Seminars for Licensing Professionals, scheduled to be held on Monday and Tuesday, March 27 and 28 at the Los Angeles Athletic Club. The brochure for this event is available online at <http://www.licensing.org/events/eventdocs/LimaSeminar06.pdf>. Mr. DeBré then stated that he may participate as a panelist at the event.

In addition, as part of this discussion, Mr. DeBré mentioned that the State Bar will sponsor two upcoming events, The Copyright Office Comes To California (February 27 in San Francisco and March 1 in Marina del Rey) and The Trademark Office Comes To California (April 3 in San Francisco and April 5 in Marina del Rey). Further information regarding these events can be found at [www.ipsection.org](http://www.ipsection.org).

#### **5. Online Discussion Board.**

Lee Rawles led a discussion about the status of establishing an online discussion board accessible through the State Bar website. He stated that he had inquired regarding linking the Licensing Committee's Google Group to the Licensing Committee's webpage on the State Bar website. He stated that these efforts were ongoing.

#### **6. Monthly Committee Conference Calls.**

After discussion, the Committee reached consensus that future monthly Licensing Committee conference calls will be held on the first Thursday of each month, beginning at 8:30 a.m. The next scheduled monthly call will take place on Thursday, April 6, 2006 at 8:30 a.m. There will be no monthly meeting in March. Mr. DeBré stated that he would post a message about this through the Google Group.

**III. Wrap-up.**

Mr. DeBré summarized the actions to be taken concerning the matters discussed during the call and confirmed that the next call will be held on April 6 at 8:30 a.m.

**Meeting adjourned.**